ATTORNEY DOCKET NO. 10030573-1

OCT 17 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Stanley Kolman, et al.

Serial No.: 10/722,183   Examiner: Toan M. Le

Filing Date: November 24, 2003   Group Art Unit: 2863

Title: METHOD AND APPARATUS FOR DETECTING AND CORRECTING INVALID TEST DEFINITION DATA

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 28, 2008   .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **$540.00**.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

[x] (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for the total number of months checked below:

☐	one month	$ 130.00
☐	two months	$ 490.00
[x]	three months	$1110.00
☐	four months	$1730.00

☐ The extension fee has already been filled in this application.

☐ (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 50-4018 the sum of _$1650.00_. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-4018 pursuant to 37 CFR 1.25.

A duplicate copy of this transmittal letter is enclosed.

[x] I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: October 9, 2008   OR

☐ I hereby certify that this paper is being submitted electronically via EFS-Web to the Patent and Trademark Office on the date shown below.

Date of submission:

Typed Name: Gregory W. Osterloth

Signature: /Gregory W. Osterloth/

Respectfully submitted,

Robert Stanley Kolman, et al.

By /Gregory W. Osterloth/
_____
Gregory W. Osterloth
Attorney/Agent for Applicant(s)

Reg. No. 36,232

Date: October 9, 2008

Telephone No. (303) 295-8205

Rev 06/05 (AplBrief)

ATTORNEY DOCKET NO. 10030573-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Robert Stanley Kolman, et al.**

Serial No.: **10/722,183**   Examiner: **Toan M. Le**

Filing Date: **November 24, 2003**   Group Art Unit: **2863**

Title: **METHOD AND APPARATUS FOR DETECTING AND CORRECTING INVALID TEST DEFINITION DATA**

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 28, 2008   .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **$540.00**.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

[x] (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for the total number of months checked below:

☐	one month	$ 130.00
☐	two months	$ 490.00
[x]	three months	$1110.00
☐	four months	$1730.00

☐ The extension fee has already been filled in this application.

☐ (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 50-4018 the sum of **$1650.00** . At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-4018 pursuant to 37 CFR 1.25.

A duplicate copy of this transmittal letter is enclosed.

[x] I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: October 9, 2008   OR

☐ I hereby certify that this paper is being submitted electronically via EFS-Web to the Patent and Trademark Office on the date shown below.

Date of submission:

Typed Name: Gregory W. Osterloth

Signature: /Gregory W. Osterloth/

Respectfully submitted,

Robert Stanley Kolman, et al.

By /Gregory W. Osterloth/

Gregory W. Osterloth
Attorney/Agent for Applicant(s)

Reg. No. 36,232

Date: October 9, 2008

Telephone No. (303) 295-8205

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No.	:	10/722,183	Confirmation No. : 7018
Appellant	:	Robert Stanley Kolman, et al.	
Filed	:	11/24/2003	
TC/A.U.	:	2863	
Examiner	:	Toan M. Le	
Docket No.	:	10030573-1	

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Table of Contents

<u>Section</u>:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No.	:	10/722,183	Confirmation No. : 7018
Appellant	:	Robert Stanley Kolman, et al.	
Filed	:	11/24/2003	
TC/A.U.	:	2863	
Examiner	:	Toan M. Le	
Docket No.	:	10030573-1	

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This "Appeal Brief" is submitted in response to the "Final Office Action" mailed December 28, 2007. Appellants filed a "Notice of Appeal" and "Pre-Appeal Brief Request for Review" on April 28, 2008. A "Notice of Panel Decision from Pre-Appeal Brief Review" was mailed June 9, 2008.

- 1 -

Real Party in Interest

The real party in interest is Verigy (Singapore) Pte. Ltd., a Singapore limited liability company.

Related Appeals and Interferences

There are no related appeals and/or interferences.

Status of Claims

Claims 1-20 are pending. Of these, claims 8, 9, 17 and 18 stand objected to as being dependent on other rejected claims, but are otherwise allowable; and claims 1-7, 10-16, 19 and 20 stand rejected. The rejections of claims 1-7, 10-16, 19 and 20 are appealed.

A copy of the claims is attached as a Claims Appendix to this Appeal Brief.

Status of Amendments

No amendments were made subsequent to final rejection. All amendments have been entered.

Summary of Claimed Subject Matter

In one embodiment (claim 1), apparatus (FIG. 1) comprises program code (FIG 1, 100; p. 4, lines 2-3) stored on computer readable media (p. 4, line 3). The code comprises: 1) code to define a user interface (106; p. 4, line 7); 2) code to detect invalid test definition data in user input (p. 4, lines 3-4) and, upon detection of invalid test definition data, prompt a user to select a valid data option from a set of valid data options; said prompting being undertaken through the user interface (FIG. 1, 106)(p. 4, lines 5-7); and 3) code (FIG. 1, 108) to receive a valid data option selected through the user interface, and to update the invalid test definition data with the valid data option (p. 4, lines 7-9).

In another embodiment (claim 14), a computer-based method (FIG. 4, 400) comprises: 1) parsing user input to detect invalid test definition data in the user input (FIG. 4, 410; p. 7, lines 8-9); 2) upon detecting invalid test definition data, prompting a user to select a valid data option from a set of valid data options (FIG. 4, 420; p 7, lines 9-10); 3) upon receiving a valid data option selected from the set of valid data options, updating the invalid test definition data with the valid data option (FIG. 4, 430; lines 12-13); and 4) generating circuit test data structures to control an automated circuit tester (FIG. 4, 440; p. 7, lines 15-16).

In yet another embodiment (claim 19), a computer-based method (FIG. 5, 500) comprises: 1) parsing source code for generating circuit test data structures, to identify type name definitions and enumeration constant definitions contained in said source code (FIG. 5, 510; p. 8, lines 10-14); 2) generating a string table from said type name and enumeration constant definitions (FIG. 5, 520; p. 8, lines 12-14); and 3) linking said string table to an input validation and error messaging portion of said source code to i) cause said source code to index said string table upon detection of invalid test definition data in user input, and then ii) cause a set of valid data options retrieved from said string table to be displayed to a user for user selection (FIG. 5, 530; p. 8, lines 14-19).

-6-

Ground of Rejection to be Reviewed on Appeal

Whether claims 1-7, 10-16, 19 and 20 should be rejected under 35 USC 103(a) as being unpatentable over Colby et al. (US Pat. No. 6,622,271) in view of Gygi et al. (US Pub. Pat. App. No. 2003/0235156).

Argument

Claims 1-7, 10-16, 19 and 20 should not be rejected under 35 USC 103(a) as being unpatentable over Colby et al. (US Pat. No. 6,622,271; hereinafter "Colby") in view of Gygi et al. (US Pub. Pat. App. No. 2003/0235156; hereinafter "Gygi").

a. Claims 1, 6-13, 14, 15, 17 and 18

Appellants' claim 1 recites:

1.   Apparatus, comprising:
computer readable media; and
program code, stored on the computer readable media, comprising:
      code to define a user interface;
      code to detect invalid test definition data in user input and, upon detection of invalid test definition data, prompt a user to select a valid data option from a set of valid data options; said prompting being undertaken through the user interface; and
      code to receive a valid data option selected through the user interface, and to update the invalid test definition data with the valid data option.

With respect to appellants' claim 1, the Examiner asserts that Colby teaches "code to receive a valid data option *selected* through the user interface, and to update the invalid test definition data with the valid data option" in col. 11, lines 52-57. See, 12/28/07 Final Office Action, p. 1. Appellants respectfully disagree.

A user cannot *select* a valid data option through a user interface unless the user is first prompted with some sort of option to select. However, as admitted by the Examiner, Colby does not disclose any sort of prompting of a user "to select a valid data option". See, 12/28/07 Final Office Action, pp. 2-3. Appellants therefore assert that Colby does not disclose "code to receive a valid data option *selected* through [a] user interface". Appellants do admit, however, that Colby discloses an interface to *receive* user input (but an interface that merely *receives* an input thought of by a user is not an interface that provides an option for a user to *select*).

Turning now to the recitation of claim 1 that recites, "code to. . ., upon detection of invalid test definition data, prompt a user to select a valid data option from a set of

valid data options; said prompting being undertaken through the user interface", the Examiner admits that this is not taught by Colby. However, the Examiner asserts that this is taught by Gygi in, for example, paragraphs [0048], [0050], [0051], [0068] and [0069]. Appellants respectfully disagree.

In paragraph [0051], Gygi appears to teach prompting a user to select a valid option from a set of valid data options. Gygi also indicates that a parameter definition language enables a test designer to specify ranges, permissible values, and messages that help a user to select a test parameter. Of note, however, Gygi says nothing about "code to *detect* invalid test definition data" or "code to. . ., *upon detection* of invalid test definition data, prompt a user to select a valid data option". Instead, Gygi discloses how a parameter definition language may be used to influence or limit a user's input, so that invalid test definition is never provided by the user.

Having summarized the teachings of Colby and Gygi individually, appellants turn now to whether it would have been obvious to one of ordinary skill in the art, at the time of appellants' invention, to combine the teachings of Colby and Gygi. The Examiner asserts that it would have been obvious "to have applied the teaching of Gygi et al. into the reference of Colby et al. to assist automated testing systems through standardized user interface and programming interface for performing circuit tests." See, 12/28/2007 Final Office Action, p. 3. Appellants disagree.

On one hand, Colby discloses a system for detecting invalid test definition data and prompting a user to supply valid test definition data. However, Colby's system does not give a user any guidance on what kind of test definition data might be valid, and instead relies on the user to *know* what test definition data would be valid. On the other hand, Gygi discloses a system that provides a user with so much guidance and structure that receiving (or needing to detect) invalid test definition data is eliminated. If Gygi's parameter definition language and associated user interface were to be incorporated into Colby's system, there would no longer be a need for Colby's system to "detect invalid test definition data", because invalid test definition data would presumably be prohibited by Gygi's structured parameter input interface.

Given this dichotomy resulting from 1) Gygi's invention being "preventive" of invalid test definition data, and 2) Colby's invention being "curative", appellants do not believe that one of ordinary skill in the art, at the time of appellants' invention, would have found it obvious to combine (and modify) the disclosures of Colby and Gygi to achieve the apparatus set forth in appellants' claim 1.

Claim 1 is believed to be allowable for at least the above reasons.

Claims 6-13 are believed allowable, at least, because they depend from claim 1.

Claims 14, 15, 17 and 18 are believed allowable, at least, for reasons similar to why claim 1 is believed allowable.

b. Claims 2-5, 16, 19 and 20

Appellants' claims 2-5 are believed to be allowable over the combined teachings of Colby and Gygi because they depend from claim 1, and for the additional reason set forth below. Similarly, appellants' claim 16 is believed to be allowable over the combined teachings of Colby and Gygi because it depends from claim 14, and for the additional reason set forth below. Appellants' claims 19 and 20 are believed to be allowable over the combined teachings of Colby and Gygi for reasons similar to why claim 1 is believed to be allowable (see section a., supra), and for the additional reason set forth below.

With respect to appellants' claim 2, the Examiner asserts that Gygi teaches "code to compile the set of valid data options based on a context of the invalid test definition data" in one or more of paragraphs [0048], [0050], [0051], [0068] and [0069]. See, 12/28/2007 Final Office Action, p. 3. Appellants respectfully disagree.

Although Gygi discloses a parameter definition language that enables a test designer to both 1) define a test parameter, and 2) guide a user's input of a valid test definition parameter, Gygi does not disclose any means for detecting or otherwise identifying invalid test definition data. As a result, Gygi necessarily fails to disclose the compilation of a set of valid data options "based on a context of. . .invalid test

-10-

definition data", as recited in appellants' claim 1.

Claim 2, and its dependent claims 3-5, are believed allowable for the above additional reason.

Claims 16, 19 and 20 are believed allowable for reasons similar to why claim 2 is believed allowable.

Conclusion

In summary, the art of record does not teach nor suggest the subject matter of appellants' claims 1-7, 10-16, 19 and 20. These claims are therefore believed to be allowable.

Respectfully submitted,
HOLLAND & HART, LLP

By: ___/Gregory W. Osterloth/_____
        Gregory W. Osterloth
        Reg. No. 36,232
        Tel: (303) 295-8205

Claims Appendix

1. Apparatus, comprising:

computer readable media; and

program code, stored on the computer readable media, comprising:

code to define a user interface;

code to detect invalid test definition data in user input and, upon

detection of invalid test definition data, prompt a user to select a valid data

option from a set of valid data options; said prompting being undertaken

through the user interface; and

code to receive a valid data option selected through the user interface,

and to update the invalid test definition data with the valid data option.

2. The apparatus of claim 1, wherein the program code further comprises code to

compile the set of valid data options based on a context of the invalid test definition

data.

3. The apparatus of claim 2, wherein the program code to compile the set of valid

data options uses the context of the invalid test definition data to index a table of

valid data options.

4. The apparatus of claim 3, wherein the program code further comprises code to

parse the user input and log valid data options into said table.

5. The apparatus of claim 2, wherein said context comprises a data type.

6. The apparatus of claim 1, wherein at least some of said user input is received through said user interface.

7. The apparatus of claim 1, wherein at least some of said user input is contained in a test definition file.

10. The apparatus of claim 1, wherein the user interface comprises code to configure how the set of valid data options is displayed through the user interface.

11. The apparatus of claim 1, wherein the user interface comprises code to define an input area to receive a specification for invalid test definition data that has been detected as invalid because it lacks a specification to make it valid.

12. The apparatus of claim 11, wherein said input area to receive a specification for invalid test definition data is configured to receive a data type.

13. The apparatus of claim 1, wherein the set of valid data options comprises a single valid data option that is replaceable by the user.

14. A computer-based method, comprising:

parsing user input to detect invalid test definition data in the user input;

upon detecting invalid test definition data, prompting a user to select a valid

data option from a set of valid data options;

upon receiving a valid data option selected from the set of valid data options,

updating the invalid test definition data with the valid data option; and

generating circuit test data structures to control an automated circuit tester.

15. The method of claim 14, wherein parsing user input comprises parsing a test

definition file.

16. The method of claim 14, further comprising compiling the set of valid data

options based on a context of the invalid data.

19. A computer-based method, comprising:

parsing source code for generating circuit test data structures, to identify type

name definitions and enumeration constant definitions contained in said source

code;

generating a string table from said type name and enumeration constant

definitions; and

linking said string table to an input validation and error messaging portion of

said source code to i) cause said source code to index said string table upon

detection of invalid test definition data in user input, and then ii) cause a set of valid

data options retrieved from said string table to be displayed to a user for user

selection.

20. The method of claim 19, wherein said index into said string table comprises a

context of said invalid test definition data.

Evidence Appendix

None.

Related Proceedings Appendix

None.